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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/557,459 04/24/00 SHOEN

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EXAMINER

PM82/0215

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ART UNIT

PAPER NUMBER

3618

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02/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/557,459

Applicant(s)

SHOEN, MARK VINCENT

Examiner

Daniel Yeagley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. The I.D.S. filed 4/24/00 has been acknowledged.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to a fender, classified in class 362, subclass 506.
- II. Claims 25-26, drawn to a dolly, classified in class 280, subclass 402.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the dolly is capable of use with or without the fenders. The subcombination has separate utility such as a fender on a motorcycle, stroller, toy or vehicle as a guard over a wheel, or as a device at the front end of a locomotive or streetcar designed to push aside obstructions or as a cushioning device, used on the side of a vessel or dock to absorb impact or friction.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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During a telephone conversation with the attorney Brennan Swain on 2/9/01 a provisional election was made to prosecute the invention of the fender, group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25 and 26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Note that the attorney did not indicate in his return phone call to the examiner if the election of group I was with or

*Amended* without traverse.

### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 - 3, 19, 20, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by McCullum et al 'D'786.

Regarding claims 1 - 3, McCullum et al 'D'786 shows a fender having a light housing mounted to the fender offset from a midline of the fender (figure 4), the external surface of the fender (figure 1) has a shape wherein the light housing comprises a base portion that conforms to at least a portion of the shape of the fender and (figure 6) shows the light housing having a raised portion adapted to receive a light fixture.

Regarding claims 19, 20, 23 and 24, McCullum et al 'D'786 shows a fender on one wheel of a trailer or dolly which inherently comprises a plurality of fenders.

6. Claims 1 - 9 and 17 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nyman '556.

Regarding claims 1 - 3 and 19, 20, 23 and 24, Nyman '556 shows a plurality of fenders 10, 11 on a trailer or tow dolly having a light housing 13 mounted to the fender 11 offset from a midline of the fender (figure 2 and 4), the external surface of the fender (figure 1) has a shape wherein the light housing comprises a base portion that conforms to at least a portion of the shape of the fender (figures 1 and 2), the light housing having a raised portion adapted to receive a light fixture.

Regarding claims 4, 17, 21 and 22, Nyman '556 (figure 4)<sup>1 & 3</sup> shows a fender 11 on a trailer or tow dolly comprising a clearance-increasing portion which is concave (note the left portion of the fender extending from the inner portion of the wheel is viewed as a clearance increasing portion).

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Regarding claim 5 - 7, Nyman '556 show a fender with a clearance increasing portion that extends downward at a non-zero acute angle of about an angle of between 1 and 89 degrees (figure 1, note the fender has an angle in a longitudinal and transverse direction), with the light housing attached to the top portion of the fender, note applicants disclosure page 7, line 25-26, the top portion extends all the down to the bottom edge of the fender.

Regarding claims 8, 9 and 18, figures 1 and 3 show an inner wall (inner lip of the fender figure 3) which extends from the clearance increasing portion and has an inner edge and further comprises an outer wall (outer side of the fender 12, figure 1) having an outer edge.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyman '556 as applied to claim 5 above in view of Poveromo '664.

Nyman '556 show a fender with a top portion which is flat in a transverse direction with respect to the longitudinal midline (figure 2 and 3) and wherein the top portion is curved in a longitudinal direction and an inner wall extends from the clearance increasing portion which has an angle of about 1 to 89 degrees and the outer wall extends from the top portion but failed to show the fender comprising a substantially flat middle section and two curved sections or a fender with a plurality of planer sections.

Poveromo '664 shows various shaped fenders with a plurality of planer sections (figure 5) and an alternative fender comprising a flat middle section and two curved sections (figure 2).

It would have been obvious to have modified the fender of Nyman with a fender having a plurality of planer or a substantially flat section for mounting a more traditional common known trailer light housing without the need for a specially shaped housing to configure to the shape of the fender for simplicity and reduced manufacturing cost and more readily available to replace a damaged light fixture.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mohan '143 disclose a light housing attached to the top portion of the fender which comprises a plurality of planar sections wherein the angle of the fender is between about 1 and 89 degrees.

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Weber '018; figure 4, Albert '898, Haynie et al '132, Poveromo '749, Huff '831 and Petty et al '994 show a light housing mounted to a fender of a trailer or dolly.

Richards '516 show a light housing mounted to a fender of a trailer or dolly with a clearance increasing portion 121.

Leonard '124, HONDA JP365 and KUBOTA JP'159 shows a light housing attached to a fender in an offset position.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley at 703-305-0838. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.Y.  
February 11, 2001

  
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2/12/01